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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/578,027	05/24/2000	Ron Cohen	50325-0125	4795

29989 7590 04/15/2004

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EXAMINER

SHAW, JOSEPH D

ART UNIT PAPER NUMBER

2141

DATE MAILED: 04/15/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

09/578,027

Applicant(s)

COHEN ET AL.

Examiner

Joseph D Shaw

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 May 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. Claim 22 recites the limitation "the prohibited network resource" in line 3. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-2, 4-17, 19-25, and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beranek et al. (6,226,642) in view of Kavner (6,366,947).

- b. As per claims 1, 11-16, and 29-30, Beranek teaches receiving a first electronic document (col. 3, lines 19-20; Fig. 7); identifying one or more symbolic references to other electronic documents within the first electronic document; creating and storing a modified copy of the first electronic document in which a substitution is made for each

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corresponding symbolic reference (col. 3, lines 27-28; col. 11, lines 3-11; Fig. 7); and delivering the modified copy of the electronic document in response to all subsequent requests for the first electronic document (caching modified documents; col. 12, lines 27-37; Fig. 7). However, Beranek does not explicitly teach determining a network address of each of the other electronic documents corresponding to each of the symbolic references and the act of substituting involving substituting the network address for each corresponding symbolic address. Kavner teaches determining the TCP/IP address of a host name and storing that TCP/IP address in a local cache (Fig. 5, col. 12, lines 44-63). Since Beranek teaches that URL's in a document can be changed, it would have been obvious to one of ordinary skill in the art at the time of the invention to have Beranek determine the network address and save it locally, as taught by Kavner, by changing the URL's in Beranek to reflect their network addresses before storing it in the cache, because having a local reference to the network address mitigates the need to retrieve the IP address from DNS, as taught by Kavner (Fig. 5, col. 12, lines 44-63), inherently increasing the speed of the system.

c. As per claim 2 and 17, Beranek discloses the claimed invention modified by Kavner as described above. However, the modified Beranek invention does not explicitly teach delivering an unmodified copy of the first electronic document in response to a client request for the first electronic document, concurrently while performing the steps of identifying, determining, creating and storing. Kavner teaches sending a copy of the document (unmodified) in the cache concurrently while

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determining if a document should be updated (modified) (col. 4, lines 44-56). It would have been obvious to one of ordinary skill in the art at the time of the invention to include delivering an unmodified copy of the first electronic document in response to a client request for the first electronic document, concurrently while modifying the document, as taught by Kavner, in the modified Beranek invention, because the user would get the benefit of seeing the web page immediately while the changed resources are updated in the background, as taught by Kavner (col. 4, lines 56-59).

d. As per claims 4 and 19, Beranek discloses the claimed invention modified by Kavner as described above and furthermore teaches storing the modified copy in cache storage of a cache server (col. 12, lines 27-35; Fig. 7).

e. As per claims 5 and 20, Beranek discloses the claimed invention modified by Kavner as described above. However, the modified Beranek invention does not explicitly teach retrieving and storing in the cache storage, each of the other electronic documents and carrying out the steps of identifying, determining, creating and storing, and delivering for each of the other documents in the cache storage, before or at the same time as receiving one or more client requests for the other electronic documents. Kavner teaches fetching all links associated with a page presently being viewed and storing them in the cache (col. 5, lines 58-63). It would have been obvious to one of ordinary skill in the art at the time of the invention to include the pre-fetching of links, as taught by Kavner, in the modified Beranek invention (that automatically performs the steps of identifying, determining, creating

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and storing, and delivering all received documents) because when a user eventually selects one of the links the page can be displayed immediately instead of waiting for it to be downloaded, as taught by Kavner (col. 5, lines 54-58).

f. As per claims 6 and 21, Beranek discloses the claimed invention modified by Kavner as described above. However, the modified Beranek invention does not explicitly teach determining that one or more symbolic references identifies a prohibited network resource and substituting a network address of a predetermined network resource for the symbolic references to the prohibited network resource. Kavner teaches a content filter or blocking feature that replaces content in a web page with other content, where the content can be any form of identifiable information (prohibited network resources; col. 19, lines 22-36). It would have been obvious to one of ordinary skill in the art at the time of the invention to include replacing prohibited symbolic references with predetermined content, as taught by Kavner, and using the network address replacement method described in the modified Beranek invention, because substituting predetermined content for prohibited content would prevent the user from viewing unauthorized or offensive material.

g. As per claims 7 and 22, Beranek discloses the claimed invention modified by Kavner as described above. However, the modified Beranek invention does not explicitly teach the predetermined network resource being a predefined electronic document that comprises a message specifying that access to the prohibited network resource is

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prohibited. "Official Notice" is taken that both the concept and advantages for providing a predefined document stating access is prohibited are well known and expected in the art (HTTP 401/403 error messages, ad blockers). It would have been obvious to one of ordinary skill in the art at the time of the invention to have a predetermined network resource being a predefined electronic document that comprises a message specifying that access to the prohibited network resource is prohibited in the modified Beranek invention because the end user would be able to see why a page is not being displayed correctly.

h. As per claims 8-10 and 23-25, Beranek discloses the claimed invention modified by Kavner as described above. Furthermore, Beranek teaches the electronic document comprising an HTML document and wherein the symbolic references comprise: only embedded URL's in the HTML document; only selected URL's in the HTML document as determined according to a selection policy; or all URL's in the HTML document (re-formatting the web page according to some given protocol or filter property; col. 3, lines 19-25).

i. As per claim 28, Beranek discloses the claimed invention modified by Kavner as described above. Furthermore, Beranek teaches the electronic document comprising an HTML document and wherein the symbolic references comprise hostnames in embedded URL's in the HTML document and hostnames in hyperlinks in the HTML document (col. 3, lines 25-31).

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5. Claims 3, 18, and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beranek et al. (6,226,642) in view of Kavner (6,366,947), as applied to claims 1 and 16 above, and further in view of Admitted Prior Art (APA).

j. As per claims 3, 18, and 26-27, Beranek discloses the claimed invention modified by Kavner as described above. However, the modified Beranek invention does not explicitly teach determining that a plurality of symbolic references identify one particular host name and substituting a different network address in each of the symbolic references that identify the particular host name, wherein each different network address is associated with one of a plurality of replicated servers. APA teaches providing different IP addresses for successive requests for the same host name, wherein each IP address identifies one of a plurality of replicated servers in different regions (page 2, lines 1-7). It would have been obvious to one of ordinary skill in the art at the time of the invention to have a host name's different IP addresses taught by the applicant substituted for the same host name during the substitution process in the modified Beranek invention because more processor power would be available on each server to deliver content, as taught by the applicant (page 1, lines 24-27).

#### ***Response to Arguments***

6. In response to applicant's argument that the Beranek reference fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a modified copy of the first electronic document in which the network address is substituted for each corresponding



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symbolic reference) are, in fact, not disclosed by Beranek. However, contrary to applicant's argument, this is not what the Office Action states. The Office Action uses the Beranek reference to teach, among other limitations, that the URLs and links (symbolic references) in an electronic document can be modified (col. 3, lines 27-28; col. 11, lines 3-11; Fig. 7) and that the modified stored and delivered upon subsequent requests for that document (col. 12, lines 27-37; Fig. 7). Nowhere does the Office Action claim that Beranek contemplates a modified copy of the first electronic document in which the network address is substituted for each corresponding symbolic reference, as argued by applicant. Rather, the examiner uses another reference in combination with Beranek to teach the limitation(s).

7. In response to applicant's argument that Beranek is only concerned with the presentation of data, and is not concerned with alleviating the need for DNS resolution, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

#### Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Shaw whose telephone number is

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703-305-0094. The examiner can normally be reached on Monday - Thursday and alternate Fridays, 7am - 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharja can be reached on 703-305-4003. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Joseph Shaw  
Examiner  
AU 2141



**RUPAL DHARIA**  
**SUPERVISORY PATENT EXAMINER**